

REMARKS

This application has been reviewed in light of the Office Action dated October 18, 2002. Claims 1, 3-8, 10-15, 17-19, 21-26, 28, and 29 are presented for examination. Claims 1, 8, 15, 19, and 26, the independent claims have been amended as to matters of form and/or to further clarify the claimed subject matter.

Initially, Applicant notes the reference on page 2 of the Office Action, "the Examiner cannot find in the claim language that the first identification information conveys information relating to copyright." In Applicant's previous response, dated March 17, 2003, at page 9, lines 11 and 12, Applicant acknowledged that claim 1 in fact recites "first identification information relating to a copyright . . .".

Claims 1, 3-8, 10-15, 17-19, 21-27, 28 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,257,119 (*Funada*) in view of U.S. Patent 5,822,660 (*Wen*).

For substantially the same reasons as those set forth in the Remarks section of the Request For Reconsideration And Petition For Extension Of Time filed on March 17, 2003, Applicant respectfully submits that Claims 1, 3-8, 10-15, 17-19, 21-27, 28 and 29 are believed patentable, in that the art relied on by the Examiner in the Office Action of October 18, 2002 does not teach or suggest hiding means for forming second identification information not easily recognizable with eye and different in form from first identification information relating to a copyright and not easily recognizable with eye, where the first identification information is formed by a first color signal, and the hiding means comprises color conversion means which performs color conversion of the image data, and forming means which forms the second identification information by a second color different from

the first color signal forming the color-converted first identification information in the color-converted image data.

As understood by Applicant, the outstanding rejection is based on the reasoning in paragraph 3 of the Office Action mailed on December 20, 2000, to the effect that it would have been obvious to modify the system of *Funada* by utilizing information like the copyright information that is generated and added by the *Wen* apparatus. In particular, current Claim 1 is rejected based on the grounds rejecting original Claim 2. In that rejection of original Claim 2, the Office Action mailed on December 20, 2000 alleges that *Funada* forms a second identification information pattern that represents a machine's serial number by a second color signal different (*Funada*: the determination circuit will determine which color signal R or G or B) will be used to add to the image at specific location; column 4, line 64 to column 5, line 29) from the first color signal (*Wen*: yellow color in column 4, lines 34-42).

However, in the remarks section attached to the Advisory Action the Examiner appears to equate the color tone of the image data as first identification (6) information relating to copyright. Applicant strongly asserts that nothing in *Funada* teaches or suggests that the color tone detected by the *Funada* apparatus "relates to copyright", but only that the apparatus compares the observed color-tone of the original presented for copying with a pre-stored profile for one or more types of documents that it is not permitted to copy. Applicant respectfully points out, however, that the types of documents referred to are ones whose copying is prohibited based on statutes to prevent counterfeiting, forgery, etc., and the *Funada* apparatus effects this detection purely on the basis of color tone.

Applicant submits that the color tone of a document does not in and of itself convey any information relating to any copyright that may subsist with respect to that document.

Further, the Examiner appears to combine *Funada* and *Wen* as disclosing a first identification information relating to a copyright which is not easily recognizable by the eye. The Examiner asserts that the detected color tone in *Funada* equates to first identification information, and *Wen* adding identification information relating to a copyright that is not easily recognized with the eye. Still further, the Examiner states that *Funada* discloses second identification information formed with yellow toner, and that the second information is added based upon the detection of the color tone (first identification information). From this interpretation of *Funada* and *Wen*, Applicant understands the combination of *Funada* and *Wen* as disclosing three items identification information, a first identification information corresponding to the detected color tone (which is easily recognizable to the eye) of *Funada*, a second identification information corresponding to the *Funada* pattern which is formed with yellow toner (not easily recognizable to the eye), and the copy restrictive information of *Wen* which is printed in a yellow color that is less sensitive to the eye. Accordingly, even if both *Funada* and *Wen* disclose adding a mark of some kind to an image, where the color of the mark in both instances is yellow, nothing has been found, or pointed out in *Funada* or *Wen* teaching or suggesting hiding means for forming second identification information not easily recognizable with eye and different in form from first identification information relating to a copyright and not easily recognizable with eye, where the first identification information is formed by a first color signal, and the hiding means comprises color conversion means which performs color conversion of the image data, and forming means which forms the second identification information by a

second color different from the first color signal forming the color-converted first identification information in the color-converted image data, as recited in claim 1.

Therefore, even if *Funada* and *Wen* were to be combined in the manner proposed in the Office Action or the remarks attached to the Advisory Action, assuming such combination would even be permissible, the resulting combination still would fail to teach or suggest those features of claim 1.

Accordingly, for at least these reasons, Applicant submits that claim 1 is clearly allowable over *Funada* and *Wen*, whether considered separately or in combination.

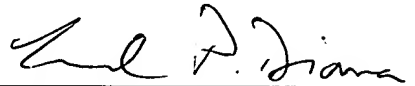
Independent claims 8, 15, 19 and 26 recite features similar to those recited in claim 1 and are thought to be patentable for the same reasons.

The other claims in this application are each dependent from one or another of the independent claims discussed above, and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Paul A. Diana", is written over a horizontal line.

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